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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,741	08/01/2003	John Frederick Ackerman	RD-26408-5	3858
7590	11/30/2004		EXAMINER [REDACTED]	PERRIN, JOSEPH L
John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metropolitan Square St. Louis, MO 63102			ART UNIT [REDACTED]	PAPER NUMBER 1746

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/632,741	ACKERMAN ET AL.
	Examiner Joseph L. Perrin, Ph.D.	Art Unit 1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 October 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Arguments

1. In view of applicant's amendment filed 01 October 2004, the status of the application is as follows:

35 U.S.C. §102(b) Rejections over Hodgens

The rejection of claims 6-16 are maintained for at least the following reasons:

In response to applicant's argument that the solutions of which Hodgens utilizes are different than that of applicant's and are used for a different purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Moreover, applicant argues that "Hodgens, II et al. do not describe nor suggest a method for washing a gas turbine engine [as claimed by applicant]". This is not persuasive because applicant is claiming an apparatus, not a method. The structural limitations of the apparatus of Hodgens reads on applicant's structural limitations of the claimed apparatus. As cited in the previous Office action, it has been held that a

recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

35 U.S.C. §102(b) Rejections over Bartos

The rejection of claims 6-16 are maintained for at least the following reasons:

Applicant argues that "Bartos, et al. do not describe nor suggest a method for washing a gas turbine engine [as claimed by applicant]" notwithstanding the fact that the claimed invention is directed to an apparatus, not a method. This is not persuasive for same reasons indicated above regarding Hodgens.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 6-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,713,120 to Hodgens, II *et al.* (hereinafter "Hodgens").

Re claims 6-10, Hodgens discloses a gas turbine wash system (11) with a pump (compressor 14) connected to a nozzle (spray probe 20) and fluid reservoirs (12/13) (see col. 5, lines 3-14). Re claim 9, Hodgens further discloses injecting fluids from both reservoirs (12/13), which reads

on applicant's limitation of the system being "configured to inject a first fluid and a second fluid..." (see col. 5, lines 44-55). Re claims 11 & 12, Hodgens teaches that it is known to clean internal parts of gas turbine engines including compressors (see col. 1, lines 53-64).

It is noted that the limitations directed to the types of fluids are considered intended use and given little weight in the apparatus claims. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In the instant case, the claims language "said washing system configured to inject a first fluid and second fluid" merely requires the system to be capable of injecting the fluids since the fluids are not positively recited limitations in the apparatus. Thus, further limitations directed to the fluids are given little weight and only require the apparatus to be capable of holding/using such fluids (which Hodgens clearly discloses, as noted above). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) It has further been held that the recitation that an element is "capable of" performing a function is not a positive limitation but

only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Similarly re claims 12-14, since the fluid limitations are directed to intended use (*i.e.* "for injecting a fluid"), the limitations directed to the configuration of the fluids is considered intended use and given little weight.

Re claims 15-16, these claims are directed to intended use (*i.e.* when the fluid is injected during a cleaning/treating operation) and given little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Recitation of Hodgens reads on applicant's claimed invention.

4. Claims 6-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,059,123 to Bartos *et al.* (hereinafter "Bartos").

Similar to Hodgens cited above, Bartos discloses the claimed structure of a turbine engine cleaning machine (10) including a pump (compressor 14), fluid reservoirs (18/20/22/24), and nozzle manifold (96) (see Figures 1, 2, 6, and relative associated text). The intended use of

types of fluids used and operation of the apparatus are given little weight (see above), and thus since the apparatus of Bartos is capable of performing such intended use, the apparatus of Bartos reads on applicant's claimed apparatus.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
6. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.
8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph L. Perrin, Ph.D.
Examiner
Art Unit 1746

jlp


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